What Israeli trademark owners and practitioners should know about U.S. trademarks

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What Israeli trademark owners and practitioners should know about U.S. trademarks

• Trademark operations
• COVID-19 special programs
• The basics of your U.S. trademark application
• Top 10 tips from law office managing attorneys
• Where to find help
Trademark (TM) operations
U.S. TM monthly filings vs. S&P 500 monthly average closing price
FY20 daily trademark application filings

- Actuals compared to revised plan (625,000 classes)
COVID-19 special programs
COVID-19 customer relief

• Priority examination program
  – For goods/services whose aim is to fight COVID-19
  – Must be subject to FDA approval
• Shortens the examination process by ~60 days
• Program started June 15, 2020
  – 171 petitions received
  – 92 petitions granted to date
COVID-19 customer relief

60 Classes:

- Vaccines; Pharmaceutical preparations: 52 (87%)
- Diagnostic kits; examination, and monitoring equipment: 5 (8%)
- Medical Services: 3 (5%)

Prosecution Status:

- 57 TOTAL
- Non-final action issued: 5
- Published for opposition: 15
- Approved for publication: 33
- Notice of Allowance issued: 4
The basics of your U.S. trademark application
U.S. trademark law—The basics

• U.S. trademark system is based on the requirement of use “in commerce”
  – Interstate;
  – Territorial; and
  – Commerce between the U.S. and a foreign country

• Use required to obtain and/or to maintain a U.S. registration

• Impacts clearance, adoption, use, and protection of trademarks in the U.S.
  – Regardless of the owner’s home country
U.S. trademark law—The basics

• U.S. law requires:
  – applicants,
  – registrants, and
  – parties to Trademark Trial and Appeal Board proceedings
    • to be represented before the USPTO by an attorney licensed in one of the 50 states
      – Effective August 3, 2019
Filing bases

- Basis for initial filing may be:
  - **Use** in commerce (interstate or between the U.S. and another country)—section 1(a)
  - **Intent to use** (bona fide intent to use in the future)—section 1(b)
  - First filed foreign application—section 44(d)
  - Foreign registration—section 44(e)
  - Madrid Protocol applications—section 66(a)
Specimen of use

• A specimen is an example of the mark being used in connection with the goods or services.
  – Goods: labels, hangtags, point-of-sale displays
  – Services: website, brochures, signs, or flyers
Trademark application timelines

• Examination:
  – Current average: 3.4 months from filing to examination

• Registration:
  – Current average: 9.7 months after filing
Maintenance required

- In the United States, registrants must submit:
  - Affidavit of continued use:
    - Between the fifth and sixth year, between the ninth and tenth year, and so on.
  - Renewal:
    - Between ninth and tenth year, and every 10 years thereafter
- Specimens of use are required
Top 10 tips from law office managing attorneys
Top 10 tips

From managing attorneys working with the office:

1. View the examiner as someone who wants to work with you to help achieve registration
   – Working with the examiner can achieve more than viewing them as an adversary
Top 10 tips—Communications

2. Pick up the phone
   - Respond/reach out to examiners ASAP if they’ve contacted you for an examiner’s amendment inquiry
   - Calling the managing attorney doesn’t get the examiner in trouble

3. If an office action is issued:
   - Read through any office action you receive before contacting the examining attorney
   - Connect with examiner soon thereafter because establishing a dialogue may overcome any potential misunderstanding(s) on either side
Top 10 tips—Applications

4. Use TEAS Plus if you need a registration quickly
   – It will make you provide more complete info and pick your ID from the manual, but you are more likely to get faster approval for publication

5. Volunteer a disclaimer
   – To eliminate an objection of clearly descriptive, generic, or incapable matter

6. Avoid common errors, e.g.:
   – Conflict between applicant name and entity type (e.g., name of individual in owner field but entity type that is LLC)
   – Ensure an accurate mark description and color claim (which match the depiction of the mark in the application)
Top 10 tips—Identifications of goods and services

7. At a minimum, use IDs only from the ID manual
   – Even if don’t want to or can’t use Teas Plus
   – Can always narrow your ID but can’t broaden it

8. Make sure you really know what the goods/services are
   – Don’t just rely on what the client said
   – Resist the patent attorney urge to draft your ID like a patent claim

9. Make sure the ID reflects the end product, not the format of the specimen on which the mark appears
   – e.g., Don’t describe the goods as “wine labels” when the product is actually wine.
Top 10 tips—Specimens of use

10. If filing a use-based application, include more than one specimen in your application
   – Per class
Where to find help
Educational resources

• Even if you are using U.S. counsel:
  – www.uspto.gov/trademark
  – “Basic Facts About Trademarks” booklet or watch the basics video.
Need more help?

- **Trademark Assistance Center**
  - Provides general information about the registration process
  - Responds to status inquiries
  - 8:30 a.m. to 8 p.m. ET, Monday-Friday
  - +1 571-272-9250 or 800-786-9199
  - Email: TrademarkAssistanceCenter@uspto.gov